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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,940	04/30/2001	Jerry A. Volquardsen	P04971US0	4674
22885	7590	09/23/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			FISHER, MICHAEL J	
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DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,940

Applicant(s)

VOLQUARDSSEN ET AL.

Examiner

Michael J. Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,4-12, 26-39,41-43 and 45-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no technological innovation in the claims. As to claim 1, this could be accomplished merely by looking at a damaged car, looking at a sheet with repair estimates on it and then saying the estimate. As to claim 12, this is a trivial use of technology as the technology is not used in this claim. As to claims 26 and 45, there is no technological innovation. The limitations in regard to the device in claim 25 and the "recording medium having indicia prompting a user..." in claim 45 could merely mean a pad of paper with boxes to be checked.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,219,930 to Reid.

As to claim 1 Reid discloses a method of estimating cost of dent repair (title), which includes gathering data (inherent in that the data is gathered), processing the information according to a pre-existing estimation program (claim 1, last two

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paragraphs), generating an estimate of repair costs (title). Reid does not, however, teach using this system for paintless dent repair (PDR). It would have been obvious to one of ordinary skill in the art to use the system as disclosed by Reid for PDR as Reid teaches it as a good way to estimate the cost of dent repair and PDR is repairing dents.

As to claim 2, Reid discloses using stored digital data (col 4, lines 25-34).

As to claim 3, Reid does not teach using a global computer network. Reid does teach using computers (col 4, lines 25-34) and it is very well known in the art to connect computers to a global computer network (the Internet). Therefore, it would have been obvious to one of ordinary skill in the art modify the system as disclosed by Reid by using the Internet to ease access to the information.

As to claims 4,20, Reid does not teach confirming that the damage is susceptible to PDR. It would have been obvious to one of ordinary skill in the art to confirm this as the system is being used for PDR and therefore, it would be inherent that the user knows if the dents can be fixed using PDR.

As to claims 5,11, the damage is dents (12, fig 1).

As to claim 6, Reid discloses characterizing the size of the dents (col 3, lines 26-31).

As to claim 7, Reid discloses identifying and characterizing clusters of dents (fig 3).

As to claims 8,21, Reid discloses confirming the cluster is contained in a predetermined area (the template) and counting the number of dents (col 3, lines 14-16).

As to claims 9,22, Reid discloses using the range of dent sizes and cluster information to estimate total cost of repairs for the vehicle (as discussed above, Reid discloses using dent size and cluster information and further discloses estimating cost in col 6, lines 11 and 12).

As to claims 10,23, Reid discloses manually counting damage and using that information to generate a repair estimation (claim 1).

As to claims 12,25, Reid does not teach using the Internet to request a web page hosted by a web server. Reid does teach using computers (col 4, lines 25-34) and it is very well known in the art to connect computers to a global computer network (the Internet). Therefore, it would have been obvious to one of ordinary skill in the art modify the system as disclosed by Reid by using the Internet to ease access to the information and further, it is inherent that Internet sites are web pages hosted by a web server.

As to claim 13, Reid discloses completing a data input template (col 4, lines 52-54).

As to claims 14,24, Reid further discloses a computer input adapted to digitally store information about body damage (fig 5), and to generate an estimation report based on inputted data (col 4, line 67- col 5, line 2).

As to claim 15, Reid does not, however, disclose two computers, Reid discloses only one computer. As is well settle in case law, duplication of parts is well within purview of one of ordinary skill in the art (see *St. Regis Paper Co. v. Bemis Co., Inc.* 193 USPQ 8,11 (7<sup>th</sup> Cir. 1977)). Therefore, it would have been obvious to one of

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ordinary skill in the art to use two computers to have a central storage of information to reduce the chance of losing data.

As to claim 16, the template has indicia to prompt recordation of certain information (col 4, lines 3-4).

As to claim 17, the worksheet is physical.

As to claims 18 and 19, the worksheet is shown to be displayable on a computer (col 4, lines 30-34).

As to claim 26, Reid discloses a hand carryable and manipulatable device (template) which has a length, width and thickness (as is inherent in three dimensional objects), a plurality of openings in the device (fig 3). Reid does not, however, teach using this system for paintless dent repair (PDR). It would have been obvious to one of ordinary skill in the art to use the system as disclosed by Reid for PDR as Reid teaches it as a good way to estimate the cost of dent repair and PDR is repairing dents Further, Reid discloses gauging the size of the dents (col 4, lines 13-18) and further, if the system is to be used for PDR it would be inherent that the dents are identified as being proper for PDR and not too small or too large.

As to claim 27, the device is shown as a sheet of material (col 3, lines 57-59).

As to claim 28, it is shown to be flexible (col 3, lines 57-59).

As to claims 29 and 30, the make up of the template is considered to be an obvious matter of design choice, therefore, it would have been obvious to one of ordinary skill in the art to use paper, or laminated paper, to make the template as this would be inexpensive and would not make losing a template too costly.

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As to claim 31, the template is shown to be plastic (col 3, lines 8-9).

As to claims 32,46, the make up of the template is considered to be an obvious matter of design choice, therefore, it would have been obvious to one of ordinary skill in the art to use regular, letter-sized paper, as this is cheap and abundant.

As to claim 33, Reid discloses indicia identifying the plurality of openings (54).

As to claim 34, it would be inherent that areas are arranged next to each other and that the next area would be closest to the preceding.

As to claim 35, the size of the openings is considered to be an obvious matter of design choice (In re Rose, 105 USPQ 347 (CCPA 1965)) and therefor is not considered to be patentably distinct.

As to claims 36,27, Reid discloses an opening larger than the other openings (fig 2 compared to fig 3).

As to claim 37, Reid discloses using a representative area to estimate total dents (col 3, lines 18-25).

As to claim 38, Reid discloses the dents as being hail damage (col 2, lines 59-61).

As to claim 39, the template would project the openings onto a vehicle (by placing it on the vehicle).

As to claim 40, Reid discloses the device as using light (scanner 60).

As to claim 41, the device is a plurality of devices (templates) each with openings (figs 2 and 3).

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As to claim 42, Reid does not teach adjustable openings. Reid does teach a need for different sized openings (col 4, lines 13-18), it would have been obvious to one of ordinary skill in the art to have adjustable openings in a template that is not transparent, as in that example, as Reid discloses templates that are not transparent (fig 3), and Reid further discloses needing to know the various sizes of the dents.

As to claim 43, Reid discloses a worksheet (equations at col 5, lines 50-56).

As to claim 44, the worksheet could be electronic (col 36-41).

As to claim 45, Reid further discloses a recording medium (computer and scanner) having indicia prompting a user to record a set of identifying information about the vehicle (this would be inherent as the computer would need to know which car was being scanned) and further, a set of information about the damage to the vehicle (dent size and number).

As to claim 48, it would have been obvious to one of ordinary skill in the art to provide an instruction sheet so the user could know how to use the template properly.

As to claim 49, Reid discloses providing a plurality of dent estimation methods (equations, col 5, lines 50-55).

As to claim 50, Reid discloses counting dents using the templates (claim 1).

As to claim 51, it would have been obvious to one of ordinary skill in the art to get clients to use the system as taught by Reid as Reid shows it as a good way to estimate damage and businesses require clients. Further, it would be inherent that the access to the information would be dependent on a level of authorization (whether allowed or not allowed.).



***Response to Arguments***

Applicant's arguments, filed 7/7/05, with respect to rejection under 35 USC 112, 2<sup>nd</sup> paragraph, have been fully considered and are persuasive. The rejection of claim 18 under 35 USC 112, 2<sup>nd</sup> paragraph has been withdrawn.

Applicant's arguments filed 7/7/05 have been fully considered but they are not persuasive. As to arguments in relation to the rejection under 35 USC 101, the basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. As such, the claims do not advance the technological arts as there is no use of the technological arts in the claims. While applicant has suggested that there is structure described in the specification. While the claims are to be read in light of the specification, there needs to be structure in the claims. Further, applicant has directed the examiner to see *J.E.M Ag Supply Inc*

*v. Pioneer Hi-Bred Int'l, Inc.*, this case is directed toward a plant patent and as such, is not analogous as there certainly is structure in a plant. While a method can be patentable, it must be performed in the technological arts else a conversation could be patented. As to claim 14, for instance, while there is a computer in the limitations, the computer is not used, it is merely "adapted to..." perform a function and, as claimed, does not perform the function, therefore, it is considered a trivial use of technology.

As to arguments in relation to the rejection 35 USC 103, applicant argues that the prior art intends a particular method, to determine averages and then extrapolate, while the instant application does not. However, applicant has not pointed out exactly where in the claims this is distinguished. For instance, claim 1 of the instant application reads thusly, "A method of...

- a. gathering information about body damage...
- b. processing the information according to *a pre-existing estimation program*.
- c. generating an estimate..."

The "*pre-existing estimation program*" could be construed to mean, "take an average of the dents in a representative area and extrapolate from there." Thus, the prior art meets this limitation.

As to Reid teaching away from the instant invention, the applicant has not shown this, as discussed above, Reid does not teach a different paradigm.

As to arguments in relation to claims 3,12,25, 7-9,21-22,36-37-(sic),13,16-19,43,44,48,49-(sic), as discussed above, these limitation would be obvious. Further, applicant has not pointed why they aren't obvious and therefore, the rejection of these

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claims is considered proper. As to arguments in relation to claim 51, merely stating that the modifications would not be obvious is not considered a valid argument and therefore, the rejection is deemed proper.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF 

9/17/05



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